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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,810	11/13/2001	Debasis Majumdar	82857LMB	5670

7590 08/26/2004
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Rochester, NY 14650-2201

EXAMINER

WYROZEBSKI LEE, KATARZYNA I

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/008,810		MAJUMDAR ET AL.	
	Examiner		Art Unit	
	Katarzyna Wyrozebski		1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-35, 37-46 and 49-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-35, 37-46, 49-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

In view of applicant's amendment mailed on 6/23/2004, which amendment further narrowed the claims from an article to extruded article following office action is final as necessitated by amendment. A limitation "...for an imaging element..." is a recitation of intended use.

Double Patenting

1. Properly filed terminal disclaimer for application 10/006545 overcame provisional double patenting rejection.

Double Patenting rejection over application 10/008428 has not been received by the Office. The rejection is therefore not overcome.

Applicant's arguments with respect to the prior art of FISHER are not persuasive and rejection is incorporated here by reference. New rejection is restated in order to more clearly indicate the extruded article.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 14-34, 37-46, 49-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over FISHER (US 6,579,927).

The discussion of the disclosure of the prior art of FISHER from paragraph 6 of the office action mailed on 9/4/2004 is incorporated here by reference.

4. Claims 48, 49, 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over FISHER (US 6,579,927) as applied to claims 1-34, 37-45, 48-51 above, and further in view of KURATSUJI (US 5,939,183).

The discussion of the disclosure of the prior art of FISHER and KARATSUJI from paragraph 7 of the office action mailed on 9/4/2004 is incorporated here by reference.

5. Claims 14-35, 37-46, 49-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'NEIL (WO 01/034685).

The prior art of O'NEIL discloses clay/polymer composite that can be formed into an article by melt blending and extrusion (page 4, lines 25-28). To be more specific, the composition is utilized in soft and tubular article.

Clay of O'NEIL is Montmorillonite type clay that can be intercalated with ammonium type compounds (page 4, line 15, page 1, line 23).

The intercalating polymer is block copolymers. Example 2 specifically discloses polyamide ether block copolymer. Claims 8 and 9 further teach that the polyamide block is nylon block and the elastomeric block is polyether, polyester and the like. Example 2 of

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O'NEIL further discloses use of second polymer, which is nylon. Specification on page 5 further teaches use of polyolefins, polyesters and the like.

The composition of O'NEIL can be utilized to make flexible extruded article having improved mechanical properties.

In the light of the above disclosure it would have been obvious to one having ordinary skill to utilize composition of O'NEIL as a base or a substrate and therefore obtain the claimed invention. Above composition can be extruded into flexible material.

In the response dated 6/23/2004 the applicants argued following:

a) The present invention relates to extruded imaging article, whereas the prior art of FISHER teaches any molded article. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Newly added prior art teaches use of such composition in extruded articles.

b) FISHER teaches away from present invention (cited col. 3, lines 61-66).

With respect to the above argument, the prior art of FISHER teaches intercalation of clay with block copolymer. With respect to the compatibility of the block copolymer, due to specific properties of the clay component one block of the polymer has to be compatible with clay in order to afford intercalation. One of ordinary skill in the art would know that. The second block

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has to be compatible with matrix polymer and have to be mixable with matrix polymer. The cited paragraph clearly depicts that. It further states that the structural units of intercalating block can be the same as those of matrix polymer. Therefore the prior art of FISHER teaches that the matrix polymer can be different from intercalating block. Along as the other matrix polymer is enabled by the prior art then the disclosure meets the claims.

c) The prior art of KURATSUJI and FISHER cannot be properly combined since they are not in the same field of endeavor (non-analogous) and their classification is entire different.

With respect to the above argument, examiner's reasons for combining the prior art of record do not have to be the same reasons as those of the applicants. The disclosures also do not have to be in the same field of endeavor but do have to reasonably provide for teachings of the rejected claims. Synthesis of the block copolymer as required by the rejected claims 48, 49 and 51 is also not the same as an independent claim calling for composition.

Classification of the prior art is hardly a convincing argument and has nothing to do with the applicability of the prior art against present claims.

d) The prior art of KURATSUJI does not teach making of extruded base for imaging element.

As stated above in paragraph c) the prior art of KURATSUJI was applied for polymerization claims.

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6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

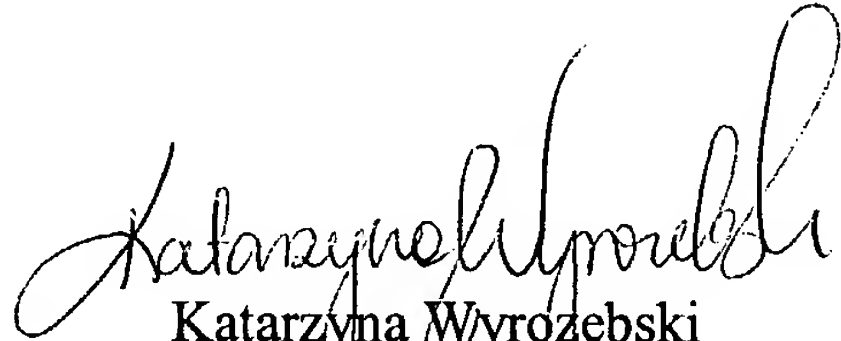
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katarzyna Wyrozebski whose telephone number is (571) 272-1127. The examiner can normally be reached on Mon-Thurs 6:30 AM-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Katarzyna Wyrozebski
Primary Examiner
Art Unit 1714

August 20, 2004